

## **REMARKS**

### **Request For Entry of Amendment<sup>1</sup>**

While Applicants continue to disagree with the decision of the Board of Patent Appeals and Interferences, in order to advance the prosecution of this application, Applicants have previously filed a RCE and are now amending independent Claims 1, 10 and 51 to recite “wherein said halogenated xanthene comprises 4,5,6,7-tetrabromoerythrosin, and wherein said radiosensitizer agent does not include a liposome.” A halogenated xanthene comprised of 4,5,6,7-tetrabromoerythrosin was the subject of prior dependent Claim 3. Hence, this is not the presentation of a new invention from the claims previously prosecuted. Further, the Examiner has not cited any reference disclosing this compound as a radiosensitizer agent, nor any disclosure of this compound. Therefore, it is respectfully requested that this amendment be entered, and the claims allowed.

In addition, Applicants are adding new independent Claim 68. Claim 68 is rewritten dependent Claim 14, which the Examiner has stated would be allowable if rewritten in independent form. Hence, Claim 68 is not the presentation of a new invention from the claims previously prosecuted. Therefore, it is respectfully requested that new Claim 68 be entered and allowed at this time.

Accordingly, as Applicants have placed this application in a condition for allowance, it is respectfully requested that this amendment be entered and the application allowed.

---

<sup>1</sup> Applicants previously filed an “Amendment D” on November 24, 2004. In the action of April 22, 2005, the Examiner refused entry of that amendment as not being fully responsive as being directed to a new invention. Applicants were encouraged to submit a new reply with the claims that were previously under prosecution and a one month period for response was set. Accordingly, Applicants are submitting this substitute “Amendment D” to replace the prior submission.

In order to show that the application has been placed in a condition for allowance, Applicants will now address each of the Board of Patent Appeals and Interference's/Examiner's rejections and comments in the order in which they appear in the Final Rejection and the decision by the Board.

### **The §102 Rejections**

#### **A. 35 U.S.C. § 102(b) – Serafini**

The Board of Appeals and Interferences decision of September 30, 2004 affirmed the rejection of Claims 1-3 and 5-8 under 35 USC §102(b) as being anticipated by Serafini. While Applicants respectfully traverse this rejection based on the reasons of record delineated in Appellants' Brief of May 13, 2002, in order to advance the prosecution of this case and allow the application, Applicants are amending independent Claims 1, 10 and 51 to recite "wherein said halogenated xanthene comprises 4,5,6,7-tetrabromoerythrosin."

Serafini does not disclose or suggest 4,5,6,7-tetrabromoerythrosin. Instead, Serafini is limited to certain diagnostic uses of radioactive <sup>131</sup>I Rose Bengal.

Therefore, since Serafini does not disclose or suggest the claimed invention, independent Claims 1, 10 and 51 and those claims dependent thereon are not anticipated nor rendered obvious by Serafini.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### **B. 35 U.S.C. § 102(b) – Neckers**

The Board of Appeals and Interferences decision of September 30, 2004 also affirmed the rejection of Claims 1-3 and 5-9 under §102(b) for alleged anticipation by Neckers. While Applicants respectfully traverse this rejection based on the reasons of record delineated in Appellants' Brief of

May 13, 2002, in order to advance the prosecution of this case and allow the application, Applicants are amending independent Claims 1, 10 and 51 to recite “wherein said halogenated xanthene comprises 4,5,6,7-tetrabromoerythrosin.”

Neckers, according to its own summary, reports and compares the optical properties, photochemical reactivity, and photophysical parameters of certain known derivatives of Rose Bengal. Neckers does not disclose or suggest 4,5,6,7-tetrabromoerythrosin.

Therefore, since Neckers does not disclose or suggest the claimed invention, independent Claims 1, 10 and 51 and those claims dependent thereon are not anticipated nor rendered obvious by Neckers.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

### **The §103 Rejections**

#### **A. 35 U.S.C. § 103(a) – Serafini or Neckers in view of Khaw**

The Board of Appeals and Interferences decision of September 30, 2004 also affirmed the rejection of dependent Claims 4, 15, 18-20 and 55 under 35 USC §103(a) as being unpatentable over Serafini or Neckers in view of Khaw. While Applicants respectfully traverse this rejection based on the reasons of record delineated in Appellants’ Brief of May 13, 2002, in order to advance the prosecution of this case and allow the application, Applicants have amended independent Claims 1, 10 and 51 to recite “wherein said halogenated xanthene comprises 4,5,6,7-tetrabromoerythrosin, and wherein said radiosensitizer agent does not include a liposome.”

As explained above, neither Serafini nor Neckers disclose or suggest 4,5,6,7-tetrabromoerythrosin. Khaw also does not disclose or suggest this feature. Hence, the claims are patentable over these references.

Additionally, independent Claims 1, 10 and 51 specifically exclude use of immuno-liposomes, which are the key feature in Khaw, as noted on p. 12 of the Board of Appeals decision. Hence, even if the combination of the immuno-liposomes in Khaw with certain unrelated teachings in Serafini or Neckers, were proper, as the Board contends in its decision on pp. 13 and 14 (which Applicants disagree with), the exclusion of such feature from the claimed invention overcomes any basis for the rejection of Claims 1, 10 and 51 in light of these references.

Accordingly, for at least the above-stated reasons, Khaw in combination with Serafini or Neckers, cannot render obvious the presently claimed invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

**B. 35 U.S.C. § 103(a) – Serafini or Neckers in view of Norman**

The Board of Appeals and Interferences decision of September 30, 2004 affirmed the rejection of Claims 10, 51, 52, 56-57 and 60-67 under 35 USC §103(a) as being unpatentable over Serafini or Neckers in view of Norman (although the basis for the Board's decision appears to be alleged anticipation by Serafini or Necker under Section 102(b), as discussed on pp. 15-16 of the Board of Appeals decision). While Applicants respectfully traverse this rejection based on the reasons of record delineated in Appellants' Brief of May 13, 2002, in order to advance the prosecution of this case and allow the application, Applicants have amended independent Claims 1, 10 and 51 to recite "wherein said halogenated xanthene comprises 4,5,6,7-tetrabromoerythrosin."

As explained above, neither Serafini nor Neckers disclose or suggest 4,5,6,7-tetrabromoerythrosin.

Norman also does not disclose or suggest this feature. Instead, Norman concerns use of certain gadolinium-containing compounds that are wholly unrelated to halogenated xanthenes or

4,5,6,7-tetrabromoerythrosin of the claims of the present application. Halogenated xanthenes do not include gadolinium, the chemical element central to the agents in Norman. Hence, the claims are patentable over these references.

Since none of Serafini, Neckers or Norman describes or suggests the claimed invention, these references cannot anticipate nor render obvious the invention of independent Claims 1, 10 and 51 and those claims dependent thereon. Hence, Applicants respectfully request that this rejection be withdrawn.

### **Conclusion**

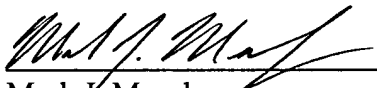
For at least the above-stated reasons, it is respectfully submitted that the claims of the present application are in an allowable form and are patentable over the cited references. Accordingly, it is requested that the application now be allowed.

If any fee should be due for this Amendment or new claims, please charge our deposit account 50/1039.

Favorable reconsideration is earnestly solicited.

Respectfully submitted,

Date: *May 17, 2005*

  
Mark J. Murphy  
Registration No. 34,225

COOK, ALEX, McFARRON, MANZO,  
CUMMINGS & MEHLER, LTD.  
200 West Adams Street, Suite 2850  
Chicago, Illinois 60606  
(312) 236-8500

Customer no. 000026568